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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,539	10/04/1999	LOUIS S. KUCERA	0044317U3	9782

28977 7590 09/16/2003

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/412,539

Applicant(s)
KUCERA et al.

Examiner
Brenda Coleman

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Aug 18, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE:

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached ADVISORY ACTION

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 56, 69-71, 95, 107, and 109-112

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 29

10. ☐ Other:

Brenda Coleman
BRENDA COLEMAN
PRIMARY EXAMINER
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ADVISORY ACTION

Claims 56, 69-71, 95, 107 and 109-112 are pending in the application.

The shortened statutory period for response expires FIVE MONTHS from the date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event however, will the statutory period for response expire later than SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

The amendment filed August 18, 2003 under 37 CFR 1.116 in response to the final rejection **has been** considered and **entered**, however the amendment is not sufficient to place the application in condition for allowance.

Response to Amendment

Applicant's amendment August 18, 2003 has been fully considered with the following effect:

1. With regards to the objection to the specification under 35 U.S.C. 132 the applicant's have not addressed this objection and thus the objection is herein **maintained**.

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2. With regards to the 35 USC § 112, first paragraph rejection of claims 56-71, 95, 96 and 103-109 of the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants indicated that "to overcome the § 112, first paragraph, and § 101 rejections, claims 56, 95, 107 and 109 have been amended to present claims directed specifically to the disclosed compounds found in the Specification, page 13, lines 1-2, and pages 21-33, Examples 5 and 6". However, while the compounds of claims 95 and 109 are described in the species of examples 5 and 6, respectively, the use of these species is not described in the specification. The statement of intended use is directed to the compounds of formula III of which these two species do not belong.

Claims 56, 69-71, 107 and newly added claims 110-112 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For reasons of record and stated above.

3. With regards to the 35 U.S.C. § 101 rejection of claims 56-71, 95, 96 and 103-109 in the last office action, the applicants' arguments have been fully considered but are not found persuasive. The applicants stated that "the specification recites as an exemplary preferred compound of Formula III, 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine". However, 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-

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phosphothymidine is not a compound of Formula III. The applicants also stated that “Examples 5 and 6 found on pages 21-23 of the specification illustrate how to make 3'-azido-3'-deoxy-5'-(3-dodecanamido-2-decyloxypropyl)-phosphothymidine and 3'-azido-3'-deoxy-5'-(3-dodecyoxy-2-decyloxypropyl)-phosphothymidine”. However, “how to make” does not satisfy the “how to use” prong of utility for the compounds.

Claims 56, 69-71, 95, 107 and 109-112 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility. For reasons of record and stated above.

Claims 56, 69-71, 95, 107 and 109-112 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for “unofficial” purposes and the actual number for **OFFICIAL** business is **308-4556**.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in cursive script that reads "Brenda Coleman". The signature is written in black ink and is positioned above the printed name and title.

Brenda Coleman
Primary Examiner AU 1624
September 11, 2003